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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/113,913 07/10/98 GUSTIN

R 62561

022242 TM02/0703
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EXAMINER

BERGIN, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SM

Office Action Summary

Application No.

09/113,913

Applicant(s)

GUSTIN ET AL.

Examiner

James S. Bergin

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION.

Priority

1. The status of the parent application 08/866,139 should now be updated in the first sentence of the specification because this application has since issued as patent number 5,897,625. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-102** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stinson et al. (6,149,056).

Note: Due to the very large number of claims (one hundred and two) in this case, the claims will not be individually referred to in the rejection that follows. If the applicant would like assistance in defining patentably distinct inventions and species from amongst the current large body of claims, then the examiner would be happy to assist in this regard.

Stinson et al. disclose a method, system and ATM 350 for dispensing cash to a user comprising: a card receiver 145; a document receiver 130; a document scanner (column 7, line 30 – column 8, line 11) for producing an image of the front and back of the check; a processor 300; a display device 105 such as a touch screen (column 7, lines 58-62); an entering device 110 for the user to enter an amount relative to the amount on the check (column 7, lines 42-45); an MICR reader (column 7, lines 50, 51) validating the code on the check; biometric devices for analysis of the biometric characteristics of a particular user (column 8, lines 12-50); optical character recognition (OCR) of the contents of the check on both sides (column 7, lines 58-65) and then use of the machine recognized check amount to calculate the difference if any, between the machine recognized check amount and the amount previously entered by the customer; an endorsement validator (column 7, lines 53, 54) for validating an endorsement signature on the back of the check; a cash dispenser (column 8, lines 15, 16) for dispensing cash to the user after the user has been qualified and the document has been validated.

Stinson et al. disclose that *designated zones* of the check are read and interpreted during this scanning and document verification process. The examiner interprets the Stinson et al. designated zones to inherently comprise an apparent signature on the signature line of the check, the courtesy amount recognition field (CAR) and the legal amount recognition field (LAR) of the scanned check image. If however the applicant takes issue with this interpretation, then the examiner takes official notice that it was notoriously well known to those of ordinary skill in the scanning

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analysis of checks for verification purposes, at the time that the invention was made, to include scanning and analysis of the signature on the signature line of a check, the CAR field and the LAR field, so as to extract and interpret the information relevant to the verification process. So, to include these regions of the scanned check image in the Stinson et al. check verification process would only be performing that which was well known to one of ordinary experience in the art of check scanning for verification purposes, at the time that the invention was made. Similarly, the examiner takes official notice that any selection of the relevant check image data by a boundary or boundary area for data extraction purposes, if not inherently present in the Stinson et al. disclosure, would have been obvious to one of ordinary skill in the art of optical scanning and data extraction, at the time that the invention was made, so as to ensure that the focus of the analysis would be on the appropriate and relevant areas of the scanned check image.

All other limitations recited in the applicant's claims that have not been specifically mentioned by the examiner in this action to date, are considered to be inherent to the Stinson et al. disclosure. If the applicant disputes this, then the examiner takes official notice that all of these limitations not previously mentioned by the examiner in the action to date, claim only that which was well known to those of ordinary skill in the art of check scanning and verification at the time that the invention was made. And so to include such features in the Stinson et al. check cashing device, would have been obvious to one of ordinary skill in the art at the time that the invention

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was made, to thereby avail of the notoriously well known components and method steps of check scanning and verification.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1-102** are rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims 1-45 of U.S. Patent No.

5,897,625 or over claims 1-21 of U.S. Patent No. 5,987,439. Although the conflicting

claims are not identical, they are not patentably distinct from each other because they

both claim essentially the same automated document cashing system, with any

differences between the claim sets being limitations comprising components or method

steps that were well within the knowledge level of one of ordinary skill in the art of check

cashing and verification at the time that the invention was made.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Stone et al. (4,628,532) discloses boundary tracing and data

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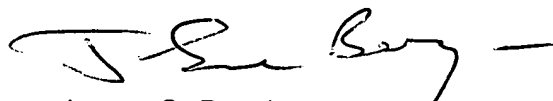
extraction in the machine identification of data; Riach et al. (5,751,842) disclose a self service document processing terminal for performing a financial transaction such as depositing a check or paying a bill, wherein the user receives a receipt and a printed image of significant portions of the check or other financial document; Crabtree et al. (5,937,084) discloses a document analysis system for identifying relevant fields within a document, which fields are then sent for optical character recognition; Bednar et al. (5,506,691) discloses an image processing and retrieval system for scanning checks at a remote site and extracting the relevant information therefrom; Shah discloses a method and apparatus for an automated check cashing system wherein the cash received can be applied to bill payment, wire transfer etc.; and Slater (EP 0 984,410 A1) discloses a check cashing ATM involving scanning of the front and back of a check to create an image of the check for verification and to provide the usual functions of an ATM machine.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.



James S. Bergin

June 21, 2001



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